

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GERALD LEE OWEN
and
STEPHEN ERIC PENROSE

Appeal No. 2005-2703
Application No. 10/689,750

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 10, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates generally to an assembled, hook-less fishing lure which ends with a snap swivel, thereby allowing the fisherman in the field to customize or adapt the lure so that it will attract a certain size, type, or species of fish desired (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,327,670¹ to Tallerico.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed April 26, 2005) for the examiner's complete reasoning in support of the rejection, and to the brief (filed February 9, 2005) and reply brief (filed May 2, 2005) for the appellants' arguments thereagainst.

¹ Issued July 12, 1994.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1

We sustain the rejection of claim 1 under 35 U.S.C. § 103.

Claim 1 reads as follows:

A modular hookless lure system comprising:
a plurality of lure module elements, each said lure module elements having a proximal end opposite a distal end, a tie eye affixed at said proximal end and a snap swivel affixed at said distal end and lure means there between;
wherein each said tie eye can be attached to any existing fishing line and any said snap swivel can be removably attached to any selected hook of choice or any other said tie eye.

Tallerico's invention relates generally to fishing tackle and equipment, and more specifically to a trolling lure having a plurality of curved blades in series on a flexible leader, with the blades providing for retention of a fish attracting scent and further providing for rotation about the flexible leader. Figure 1 shows a trolling lure 10 having spoons or spinners 12, 14, and 16 installed upon a flexible cable leader 18. A series of

beads 20, which may be plastic or glass and may be variously colored and/or reflective, is also strung along the length of the leader 18, at various points. Clevises 22 securing the spoons 12, 14 and 16 to the leader 18 are separated from the beads 20 by glass bearings 24. These various components may be separated and spaced along the leader 18 by means of sleeves 26 which are crimped or swaged to deform into the individual strands of the leader cable 18, to provide a secure means of attachment and spacing of components to the leader 18. Sleeves 26 are also used to secure portions of the cable leader 18 back onto itself, to form loops or eyes 30 for the attachment of hooks, weights, fishing line, etc. by means of swivel snap hooks 32, and intermediate swivels 34, as desired.

Tallerico's trolling lure 10 is used by trolling or otherwise moving the lure through the water, to impart a spinning or fluttering action to the spinners 12, 14, and 16. The relatively dull and non-reflective surface of the spinners 12, 14, and/or 16, provides a realistic appearance of a small group or school of small fish turning and darting near the surface of the water. Realism is further provided by the relative flexibility of the relatively thin, multiple strand cable leader 18, which allows the spinners or spoons 12, 14 and 16 to move laterally to a certain extent as they are drawn through the water. The relatively light weight of the spoons or spinners enables the lure 10 to be trolled or moved through the water at relatively slower speeds, for even greater realism and

increases the likelihood of a larger fish investigating and striking the lure 10. The preferably multi-colored glass or plastic beads 20 interspersed along the length of cable leader 18 also serve to attract fish, which are known to be generally attracted to such colorful objects. The beads 20 serve to simulate insects or fish eggs, and the general appearance of the lure 10 of the present invention is of a small school of smaller fish (represented by the spoons or spinners 12, 14 and 16) which are feeding upon insects or fish eggs (represented by the beads 20). The resulting appearance serves to efficiently attract larger fish.

In the rejection before us in this appeal the examiner ascertained that Tallerico discloses the claimed lure system except that it discloses a single lure module element, not a plurality of lure module elements. The examiner then concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a plurality of lure module elements, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

The appellants argue that Tallerico discloses only a trolling lure, not capable of being cast and not modular. Therefore, the advantages and features of the present invention are neither anticipated nor disclosed by Tallerico. The appellants assert that

it appears that only in hindsight does the claimed invention appear obvious to one of ordinary skill in the pertinent art.

We find ourselves in agreement with the examiner in this appeal. Claim 1 is directed to a modular hookless lure system having a plurality of lure module elements. Each lure module element having a proximal end opposite a distal end, a tie eye affixed at the proximal end and a snap swivel affixed at the distal end and lure means there between wherein each tie eye **can be** attached to any existing fishing line and any snap swivel **can be** removably attached to any selected hook of choice or any other tie eye. As such, claim 1 is directed to a modular hookless lure system wherein the plurality of lure module elements are not claimed as being connected together as shown in Figure 5. Accordingly, the examiner's ascertainment that Tallerico discloses the claimed lure system except that it discloses a single lure module element (i.e., trolling lure 10), not a plurality of lure module elements is correct. In our view, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have provided a plurality of Tallerico's trolling lures 10 (i.e., lure module elements) having different arrangements of spoons or spinners 12, 14, and 16 and beads 20 in a fisherman's tackle box since it was well known in this art to have a plurality of different lures in a tackle box.

In view of our determination of obviousness above, we find the appellants' argument unpersuasive. While Tallerico's trolling lure may not be capable of being cast,² such is not required by claim 1. As to the modular requirement of claim 1, we believe such is clearly met by Tallerico's trolling lure. As to the appellants' assertion that it appears that only in hindsight does the claimed invention appear obvious to one of ordinary skill in the pertinent art,³ it is our view that such is not the case in the rejection of claim 1. In this case, the teachings of Tallerico are sufficient to have suggested the subject matter of claim 1 to one skilled in the art for the reasons set forth above.⁴

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed.

² Attorney argument in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

³ The use of hindsight knowledge derived from the appellants' own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁴ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996).

Claims 2 to 9

The decision of the examiner to reject claims 2 to 10 under 35 U.S.C. § 103 is also affirmed since the appellants have not argued separately the patentability of any particular claim apart from the others, thus allowing claims 2 to 10 to fall with claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 10 under 35 U.S.C. § 103 is affirmed.

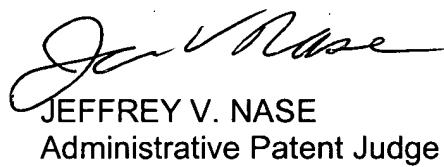
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



JOHN P. McQUADE
Administrative Patent Judge

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JEFFREY V. NASE
Administrative Patent Judge

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JENNIFER D. BAHR
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